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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/506,335

09/02/2004

Eiko Kato

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SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

EXAMINER

GULLEDGE, BRIAN M

ART UNIT

PAPER NUMBER

1619

MAIL DATE

DELIVERY MODE

07/02/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/506,335	Applicant(s) KATO ET AL.	
	Examiner Brian Gullede	Art Unit 1619	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,3 and 7-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2,3 and 7-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/10/09</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Previous Rejections

Applicants' arguments, filed April 12, 2009, have been fully considered. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 2-3 and 7-14 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Weber et al. (*Free Rad. & Med.*, 1997, 22(5), pages 761-769) in view of Takata et al. (*J. Pharm. Sci.*, 1995, 84(1), pages 96-100). Applicant argues that the rejection is not proper as Weber et al. fails to disclose the use of acetate derivatives of tocopherol, and thus there is no overlap between the teachings of Weber et al. and Takata et al. Furthermore, the Applicant argues that in response to a previous action “the overlap in scope of a compound between the present invention and Takata et al. was deleted from the claims” and thus the composition of the instantly recited claims is not taught or suggested by Weber et al. in view of Takata et al.

The Examiner is not persuaded by these arguments. Weber et al. does discuss an acetate derivative of tocopherol. As stated in the previous action, one material discussed by Weber et al. is an acetate derivative of tocopherol (“ α -tocopheryl acetate”) which delivers high concentrations

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of the agent into the skin (page 767, left column, first full paragraph, lines 4-7). Furthermore, the material discussed by Takata et al. is also referred to as “ α -tocopheryl acetate” (see, for example, page 96, second full paragraph, lines, lines 9-14). So not only does Weber et al. disclose an acetate derivative of tocopherol, but there is overlap between the teachings of Weber et al. and Takata et al.

As to the argument that the overlap in scope between Takata et al. and the claims has been deleted, the Examiner is not sure what “overlap” is being referred to by the Applicant. If the Applicant is arguing that the rejection is not proper because α -tocopherols are excluded by the instant claims, this argument is not found persuasive. The teachings of Weber et al. are not limited to just Weber et al. is α -tocopherol, and encompass other tocopherols which do lie within the scope of the claims.

Claims 15-17 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Weber et al. (*Free Rad. & Med.*, 1997, 22(5), pages 761-769) in view of Takata et al. (*J. Pharm. Sci.*, 1995, 84(1), pages 96-100) as applied to claim 2 above, and further in view of Yasuaki (JP 62-106005). Applicant argues that the rejection is not proper as Weber et al. is directed to coping with oxidative injury resulting from UV irradiation, and not directed to whitening of the skin.

The Examiner is not persuaded by this argument. Weber et al. is not being relied upon alone for the teaching that the composition is used to whiten the skin. Rather, the teachings of the references together were relied upon. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re*

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Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Claims 2-3 and 7-17 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Burke et al. (*Nutrition and Cancer*, 2000, 38(1), pages 87-97) in view of Takata et al. (*J. Pharm. Sci.*, 1995, 84(1), pages 96-100). The Applicant argues that the rejection is not proper as Burke et al. teaches away from the use of forms of tocopherol other than α -tocopherol. The Examiner is not persuaded by this argument. While Burke et al. does teach that the α -form reduces skin damage more effectively than the other forms of tocopherol, this does not mean that Burke et al. has not taught the use of the other forms. Burke et al. does demonstrate that they are effective for treating damage (page 87, paragraph [4]). And disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or non-preferred embodiments. See MPEP 2123.

Conclusion

No claims are allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Gulledge whose telephone number is (571) 270-5756. The examiner can normally be reached on Monday-Thursday 6:00am - 3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frederick Krass can be reached on (571) 272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BMG

/Frederick Krass/
Supervisory Patent Examiner, Art Unit 1612